

REMARKS

By this response, Applicant has cancelled claim 1, amended certain other claims and added new claims. The claims presented in the application are claims 2 -48.

1. Double Patenting

The Examiner has asserted a provisional rejection based upon obviousness double patenting. Applicant offers to submit a terminal disclaimer should the same become necessary to secure allowance of the claims.

2. The Merits

Turning to the merits, the Examiner relies on Fuchs 5,630,753 to reject claims 1 - 4. Applicant has cancelled claim 1 in favor of new claim 37. Claim 37 recites a method which includes selecting and displaying card data from a data structure to define an outcome for a hand of play. As described in the specification, the game may be Blackjack, Baccarat, Poker or the like. If the outcome is a winning outcome according to the predetermined rules of the game, the player gets an award. Claim 37 also recites depleting the card data available for selection and display for subsequent selection and display, of the card data which has previously been selected and displayed. Further claim 37 recites displaying information to the player of any winning outcome eliminated by the depletion of the available data. This feature is disclosed in the specification at page 13, lines 19 - 23.

Fuchs ' 753 does not disclose or suggest the features of claim 37, including the feature of displaying information that certain outcomes have been eliminated by deck depletion. Fuchs '753 in fact teaches away from this feature by providing:

" In order to ensure that an adequate number of game symbols is available at all

times, provision can be made that after a certain number of games or after a certain number of game symbols have appeared, the number of available game symbols can be added to in a random fashion or predetermined fashion..." Col 10, lines 1 - 6.

Thus, Fuchs '753 teaches that there must always be an adequate amount of game symbols to provide a chance for winning each winning outcome. Applicant, on the other hand, lets depletion occur even to the point where certain outcomes can become unavailable. Allowance of claim 37 is respectfully requested.

Claims 2 - 10 have been amended to depend directly or indirectly from claim 37 and to recite consistent language. Further, Fuchs '753 does not disclose or suggest the feature of reconstituting the inventory to the original N data on player command, depletion to a certain level or based upon a trigger as recited in the claims, particularly claims 4, 5, 8 and 9.

In regards to claim 5 the Examiner has also cited Richardson '809. It is submitted that Richardson '809 does not disclose or suggest the features of claim 5. In Richardson '809, the player is selecting "tickets" from a predetermined ticket set. As is known in the pull tab art to which Richardson '809 is directed, the ticket set includes a predetermined number of tickets, e.g. 500, and each ticket has printed thereon a winning or losing outcome much like a scratch-off lottery ticket. The distribution of winning versus losing outcomes and the prizes for winning outcomes is predetermined such that the sale of the ticket set for the play of the game can produce a profit. Thus, for example, if there are 500 tickets in the pull -tab ticket set, and each ticket sells for \$1, the sale of all tickets would bring in \$500. To turn a profit, the sum of all winning

outcome awards would be less than \$500. Thus, the only thing in Richardson '809 that is random, is the selection of a ticket from the ticket set which is akin to pulling a ticket from bowl containing all tickets. The outcome for that ticket is not random since the symbols for that ticket are predetermined and were long ago printed on or determined for the ticket and were chosen to conform to the profit criteria described above. Thus the symbols for the outcome (ticket) are NOT randomly selected from a data structure when the player makes the wager and prompts play. Nor is there any requirement to assess the cards selected to determine whether the randomly selected cards are a winning or losing outcome since, in Richardson '809, the ticket when printed or stored in memory (well before the purchase by the customer) was already determined to be a winner or a loser.

"Deal" as used in Richardson '809 has a different meaning than randomly selecting cards from a data structure of cards to define an outcome as recited in Claim 37. Richardson '809 states:

"... he has the opportunity to select a new Deal Screen 28 ... with a new offering of nine chances" Col. 11, lines 48-49.

"This is the procedure of playing a deal only so long as at least one of the higher level winners ... remains available to be won within the deal." Col. 16, lines 31-34.

Thus "deal", in the context of Richardson '809, means either the display of chances (tickets) or the entire inventory of tickets for a particular pull-tab game. When Richardson '809 refers to allowing a new deal after all of the tickets have been redeemed, he is referring to a new inventory set of pull tab tickets. For example, during

the play of a pull tab game (sale and revelation of the tickets of the inventory), the player does not have the opportunity to reconstitute the ticket set inventory. He must, if he wants to go to a game with more tickets left in the inventory, go to another game. It should be understood that in pull tab games the number of tickets in the inventory is strictly controlled by gaming regulations. Thus in the pull tab art, allowing a player to add more tickets (reconstitute) to the set would not be permitted since the same would affect the overall performance of the game. For example, if the pull tab game had only sold 20% of the tickets but most of the prizes had been won, reconstituting the inventory of tickets would render the previous deal (ticket inventory set) unprofitable.

It therefore is submitted that Richardson '809 teaches away from the present invention by (1) being directed to a pull tab game as opposed to a game where cards are selected after the player's wager to define outcomes (2) not permitting reconstitution of the original inventory of card data and (3) further for not displaying which outcomes have been eliminated by depletion of the data by selection and display. Richardson '809 shows winners which remain in the ticket inventory since the number and amount of all winners is predetermined. In Applicant's game, the number of winners or losers is not predetermined but is randomly decided by selection and display of the card data.

Applicant also respectfully submits that the combination of Richardson and Fuchs does not render the invention obvious. The Examiner bears the initial burden of factually supporting a prima facie case of obviousness. MPEP § 2142. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner

must present a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of teachings of the references. MPEP §2142.

To establish a *prima facie* case of obviousness, there must be some **suggestion or motivation** (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) **to modify the reference** teachings. The prior art reference (or references when combined) must teach or suggest **all the** claimed limitations. MPEP §2143. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is **some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to those skilled in the art.** *In re Fine* 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.01. A statement that modifications of the prior art, to meet the claimed invention, would have been well within the ordinary skill in the art at the time the claimed invention was made, is not sufficient to establish *prima facie* obviousness without some **objective reason to combine the teachings of the prior art.** MPEP §2143.01. Further, if the proposed modification of the prior art would **change the principle of operation** of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious. MPEP §2143.01.

There is no suggestion or disclosure for the combination of the references. As stated above Richardson is directed to a pull-tab game, which is quite different from the game set forth in the claims. Richardson thus does not permit the player to reconstitute the inventory as recited in the claims but instead requires the player to go

to a new game. In Richardson when all the major prize winners have been sold, the deal (game remaining set of tickets) may be retired; however the player cannot re-set or reconstitute the set back to an original number of tickets. Those skilled in the art of pull tab games would not have understood Richardson to allow the player to reset the ticket inventory since the same would affect the profitability of the ticket set and the seller and gaming authorities would lose control of the game. Thus Richardson teaches away from a player being able to reconstitute the game symbol set.

Allowance of claim 5 is respectfully requested.

Claim 11 has been amended to recite the feature of display of elimination of an outcome based upon depletion. For the reasons advanced above, allowance of claim 11 is respectfully requested.

Claims 12 - 16 depend from claim 11. For the reasons set forth in regards to claims 2 - 10 and allowance of claims 12- 16 is solicited.

Claim 17 is a method claim drawn to video Poker and has been amended along the lines of claim 37. For the reasons set forth in regard to claim 37, allowance of claim 17 is requested.

Claims 18 - 26 depend directly or indirectly from claim 17. Allowance of these claims is also requested.

Claim 27 is a device claim for video Poker amended along the lines of claim 11. Allowance of claim 11 is therefore requested.

Claims 28 - 36 depend directly or indirectly from claim 27. Allowance of these claims is respectfully requested.

New claims 38 - 41 depend from claim 37. For the reasons advanced above,

allowance of claims 38 - 41 is requested.

New claim 42 sets forth a method which includes storing data representative of the value and suits for a deck of cards. The claims also recites the display of a tally of the remaining data depleted of the cards displayed for preceding hands including the display of any card values or suits which have been completely deleted. Fuchs, as discussed above, does not permit the complete depletion of an indicia. Further Fuchs does not disclose the display of the tally of values and suits of cards. Allowance of claim 42 is requested.

New claim 43 depends from claim 42 to recite displaying outcomes which are rendered unavailable by said depletion. For the reasons advanced above and the failure of the cited art to disclose or suggest this feature allowance of claim 43 is requested. Further, Fuchs teaches away from this feature by preventing depletion of symbols.

New claim 44 recites a method along the lines of claim 43. Allowance of new claim 44 is requested.

New claim 45 depends from claim 44 and recites the display of card values and suits remaining available (the inventory remaining after depletion). For the reasons advanced above, allowance of claim 45 is requested.

New claim 47 recites an electronic device along the lines of method claim 44. Allowance of this claim is also requested.

New claim 48 depends from claim 47 to recite that the processor is configured to control the display to display the inventory of cards which have not been excluded from selection, i.e. the cards remaining after depletion...

Conclusion

In view of the amendments and remarks, allowance of all claims is requested.
Applicant respectfully requests a telephone interview to resolve any remaining issues

Respectfully submitted,

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